

REMARKS

I. Introduction

Applicants have filed concurrently herewith a Request for Continued Examination responsive to the Final Office Action, and have paid the fees set forth under 37 C.F.R. §§ 1.114 and 1.17(e).

Claims 1-76 are pending.

Claims 1-76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fries, U.S. Patent No. 6,317,885 ("Fries") in view of Goodhand et al., U.S. Patent No. 5,923,848 ("Goodhand"), the "Fries-Goodhand Combination."

These rejections are respectfully traversed.

II. Applicants' Reply To The Rejections Under 35 U.S.C. § 103(a)

Claims 1-76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fries-Goodhand Combination. However, applicants respectfully submit that, for the reasons set forth in detail below, the Examiner has failed to establish a *prima facie* case of obviousness and the § 103 rejections should therefore be withdrawn. See MPEP §§ 2142 and 2143.

A. The Fries-Goodhand Combination Fails to Show Or Suggest All Elements Of Applicants' Claimed Invention

Applicants' system and method of independent claims 1 and 20 generally relate to providing e-mail reminders for an "Internet television program guide." As set forth in independent claims 1 and 20, "a web server provid[es] ... web pages of television program listings

over the Internet" to a user's multimedia system. The user is provided with an opportunity to "select a television program from the television program listings" and to "order at least one e-mail reminder message" for a selected television program listing. E-mail reminder messages are sent "over the Internet via e-mail" to "remind the user when [the selected] television program is to be broadcast." Dependent claims 2-19 and 21-76 include additional patentable features.

The Examiner correctly acknowledges that Fries "remains silent on the specific teachings of e-mail for transport of reminder messages" and attempts to fill this admitted gap with disclosure found at column 25, line 67 - column 26, line 23 of Goodhand. See page 3 of the Office Action. However, this section of Goodhand simply shows that e-mail messages may be "flagged" and that reminders for the flagged messages may be generated locally by the e-mail system at a predetermined period of time prior to a due date associated with the message (e.g., using the computer to compare the due date data for each message with the given time). Goodhand does not show or suggest, however, "send[ing] the e-mail reminder message **over the Internet via e-mail**" as specified by applicants' claims 1 and 20, and nothing in Fries compensates for this deficiency in Goodhand.\*

Moreover, applicants reiterate that Fries does not show or suggest an Internet television program guide

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\* In Fries, e-mail data is sent to a specific set-top box via the out-of-band modulator 60 (FIG. 2) and the out-of-band tuner 71 (FIG. 3), in the same manner that a specific box is enabled for receiving a pay-per-view movie (e.g., over a cable network, not over the Internet). See column 33, lines 21-27; see also column 4, line 64 - column 5, line 6.

for "providing **web pages** of television program listings **over the Internet**" as specified by applicants' claims 1 and 20. See page 7 of applicants' Reply to the November 6, 2002 Office Action. In response to this argument, the Examiner contends that Fries does explicitly disclose this feature of applicants' claims in FIG. 6 and at column 33, lines 19-44. See pages 15 and 16 of the May 19, 2003 Final Office Action.

FIG. 6 of Fries simply shows that access to an Interactive Information Service may be provided. The Interactive Information Service of Fries, however, transmits **pre-rendered images** of information over a **cable network** (e.g., as video signals for a designated television channel) using out-of-band data multiplexer 60. See FIG. 1 and the accompanying text at column 3, lines 21-41; see also FIG. 2 and the accompanying text at column 3, line 41 - column 4, line 16; see also column 4, line 54 - column 5, line 6; see also column 6, lines 43-55 of Fries. The pre-rendered images of information in Fries are not "web pages," and, moreover, transmissions in Fries occur over a cable network and not "over the Internet" as specified by applicants' claims 1 and 20.

Column 33, lines 19-44 of Fries shows that one-way e-mail broadcasts may be provided to users and that the e-mails may be implemented using **pre-rendered images** (e.g., using HTML forms in conjunction with an on-screen display frame buffer for superimposing alphanumeric characters, other symbols and bitmap graphics over a displayed image). Again, this section of Fries does not show or suggest "providing **web pages** of television program listings **over the Internet**" as specified by applicants' claims 1 and 20.

Nothing in Goodhand compensates for this deficiency in Fries.

In addition, applicants respectfully submit that, because the Examiner concedes that "Fries remains silent on the specific teachings of e-mail for transport of reminder messages" (see page 3 of the Office Action), Fries must also fail to show or suggest "allow[ing] the user to **order at least one e-mail reminder message**" as specified by applicants' claims 1 and 20. Nevertheless, the Examiner indicates that this feature of applicants' claims is shown in the table at column 33 of Fries. However, the specified table only indicates that user-specific data may be stored in a set-top box and used for various functions (e.g., a user's name and address may be used to electronically order tangible goods to be delivered to the user's address). Accordingly, applicants respectfully submit that this section of Fries does not show or suggest "allow[ing] the user to order at least one e-mail reminder message" as specified by applicants' claims 1 and 20. Nothing in Goodhand compensates for this deficiency in Fries.

For at least the foregoing reasons, applicants respectfully submit that the Fries-Goodhand Combination does not show or suggest all features of applicants' claimed invention and that the § 103 rejections should be withdrawn. See In re Royka, 490 F.2d 981 (CCPA 1974); see also MPEP § 2143.03.

B. The Examiner Does not Provide a Sufficient Motivation for Making the Fries-Goodhand Combination

In response to applicants' previously presented arguments, the Examiner states that "the test [for obviousness] is what the combined teachings of the

reference would have suggested to those of ordinary skill in the art." See page 16 of the Office Action, referencing In re Keller, 642 F.2d 413 (CCPA 1981). The Examiner further states that:

... Fries already utilizing well known teachings of email notification, would have also look[ed] into the field of email notification **to further enhance the system** by allowing for email notification for specific events. Such as taught by Goodhand.

See page 16 of the Office Action (emphasis added). However, the Examiner fails to state **why** Fries would have enhanced the system to incorporate applicants' claimed approach. See In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002) ("The central question [for whether to combine references] is whether there is **reason** to combine the references, a question of fact . . .") (emphasis added).

Instead of providing a **reason** or motivation to combine the references, the Examiner merely concludes that:

... it would have been obvious for one of ordinary skill in the networking art to modify or incorporated [sic] Goodhand's teachings of electronic mail system for providing auto-response to certain events with the teachings of Fries, **to provide a system for generating email reminders for specific events at specific times**, and since Fries does provide a system for receiving email notification as well as reminders for specific events the motivation to combine the two references is met.

See page 3 of the Office Action (emphasis added). However, this statement is tantamount to saying that the **only reason** one would be motivated to combine Fries with Goodhand is to arrive at applicants' claimed approach. Such a conclusory statement is deficient for several reasons.

First, it is well-settled that an Examiner can establish a *prima facie* case of obviousness "only by showing some objective teaching . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." See In re Fine 837 F.2d 1071, 1074. However, the motivation provided by the Examiner in this case lacks any objective basis whatsoever and is grounded in the Examiner's subjective contention that one skilled in the art would have been motivated to arrive at applicants' claimed approach given the teachings of Fries and Goodhand. Indeed, the factual question of a motivation to combine references must be "based on objective evidence of record" and "cannot not resolved on subjective belief and unknown authority." See In re Lee at 1342; see also In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[b]road, conclusory statements standing alone are not 'evidence' of a motivation to combine").

Second, by relying on the explicit teaching of applicants' claimed invention as the motivation for combining the references, the Examiner "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. See In re Dembicza, 175 F.3d 994 at 999. Indeed, "it is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher." In re Lee at 1344.

For at least the foregoing reasons, applicants respectfully submit that the motivation for combining Fries and Goodhand relied upon by the Examiner is improper and insufficient for supporting a rejection based on

obviousness. The § 103 rejections based on the Fries-Goodhand Combination should therefore be withdrawn.

V. Conclusion

The foregoing demonstrates that claims 1-76 are patentable over the Fries-Goodhand Combination. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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